



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------------------------------------------------------------------------|-------------|----------------------|--------------------------|------------------|
| 10/811,845 | 03/30/2004 | Christophe Gauthier | 116598-00114 | 2328 |
| 27557 7590 12/29/2006 BLANK ROME LLP 600 NEW HAMPSHIRE AVENUE, N.W. WASHINGTON, DC 20037 | | | EXAMINER HINZE, LEO T | |
| | | | ART UNIT 2854 | PAPER NUMBER |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
| 3 MONTHS | | 12/29/2006 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/811,845

Applicant(s)

GOUTHIER ET AL.

Examiner

Leo T. Hinze

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Art Unit: 2854

DETAILED ACTION

Claim Objections

1. Claim 9 is objected to because of the following informalities: claim 9 depends from cancelled claim 3. To expedite prosecution, the examiner will consider claim 9 as depending from claim 1.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 4-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Lange, US 2,885,561 (hereinafter Lange).

a. Regarding claims 1 and 10, Lange teaches a dial, comprising: a substrate plate (45, Fig. 12); a semi-transparent layer (17, 30, Fig. 12) covering at least part of said substrate plate of a material allowing light to pass; phosphorescent, fluorescent or luminescent luminous elements (20, Fig. 12) lodged between said substrate plate and said semi-transparent layer; wherein said luminous elements form an image visible in darkness but essentially invisible under normal lighting conditions (col. 1, ll. 38-45).

Art Unit: 2854

- b. Regarding claim 4, Lange teaches all that is claimed as discussed in the rejection of claim 1 above. Lange also teaches the same structure that would result if said luminous elements were applied by serigraphy, tampography or manually onto said substrate plate and/or onto said semi-transparent layer. Applicant should note that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP § 2113.
- c. Regarding claim 5, Lange teaches all that is claimed as discussed in the rejection of claim 1 above. Lange also teaches wherein said semi-transparent layer is made of plastic ("synthetic resin," col. 5, ll. 1-2).
- d. Regarding claim 6, Lange teaches all that is claimed as discussed in the rejection of claim 1 above. Lange also teaches a colored layer (30, Fig. 12) interposed between said substrate plate and said semi-transparent layer.
- e. Regarding claim 7, Lange teaches all that is claimed as discussed in the rejection of claim 6 above. Lange also teaches wherein said colored layer is a coat of varnish ("translucent brilliant varnish base," col. 3, ll. 4-5).
- f. Regarding claim 8, Lange teaches all that is claimed as discussed in the rejection of claim 1 above. Lange also teaches the same structure that would result if said blind hollows were made by machining or by selective chemical attack. Applicant should note that even though product-by-process claims are limited by and defined by the process, determination of patentability is

Art Unit: 2854

based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP § 2113.

g. Regarding claim 9, Lange teaches all that is claimed as discussed in the rejection of claim 1 above. Lange also teaches the same structure that would result if said blind hollows were made by machining or by selective chemical attack. Applicant should note that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP § 2113.

Response to Arguments

4. Applicant's arguments filed 23 October 2006 have been fully considered but they are not persuasive.

5. Regarding the rejection of the claims under Lange:

a. Applicant argues on p. 6 that semi-transparent layer 30 does not cover the substrate plate 45. The examiner disagrees. Fig. 12 shows that semitransparent layer 30 covers the portion of substrate 45 on which the luminescent material 20 is placed. This corresponds to the claim language that the semi-transparent layer must cover "at least part of said substrate plate."

b. Applicant argues on pp. 6-7 that the luminous elements in Lange are not invisible under

Art Unit: 2854

normal lighting conditions. The examiner disagrees. Lange teaches that “the partly translucent reflecting layer is visible when the intensity of outside light reflected by the translucent reflecting layer exceeds the intensity of light rays emitted by the luminescent body and passing through the partly translucent layer” (col. 1, ll. 51-56). This means that when the light level is high enough, the light reflecting off the translucent layer 30 overpowers the light emitted from the luminescent elements 20, making the reflecting layer visible, but the luminous layer invisible. When the light level is low enough, the light from the luminescent elements penetrates the translucent layer, making the luminescent elements visible. Therefore, the luminous elements are *essentially* invisible under *normal* lighting conditions.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2854

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leo T. Hinze whose telephone number is (571) 272-2167. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571) 272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Leo T. Hinze
Patent Examiner
AU 2854
03 August 2006



REN YAN
PRIMARY EXAMINER